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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,224	09/24/2004	Shigeki Seto	2004-1393A	5141

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WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

KIFLE, BRUCK

ART UNIT PAPER NUMBER

1624

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,224

Applicant(s)

SETO ET AL.

Examiner

Bruck Kifle, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) The phrase “fused bicyclic pyrimidine derivative” and the term “general” renders the claims indefinite because the metes and bounds of a derivative cannot be ascertained. The term “general” implies more than what has been positively recited in the claim is intended. Language, such as “compound of formula (1)” is suggested throughout the claims. Deletion of the term “general” is also suggested.

ii) It is unclear what kind of ring is intended to form by adjacent substituents on rings A and B. How many rings are intended?

iii) The kind of composition intended in claim 16 is unclear. Should Applicants intention be a pharmaceutical composition, then, presenting a claim such as “A pharmaceutical composition comprising an effective amount of a compound of formula (I) according to claim 1 and a pharmaceutically acceptable carrier” is suggested.

iv) Regarding claims 12, 13 and 15 the phrase “such as” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

v) In claims 10 and 11 it is unclear who needs the introduction of a tachykinin receptor antagonist or an NK1 receptor antagonist, what is accomplished and what the differences are between these claims. Both claims require the introduction of the same compound of claim 1. A clarification is required.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The how to use portion of the statute has not been addressed. This means that Applicants must teach the skilled practitioner, in this case a physician, how to treat a given subject. The physician clearly must know what disease and what symptoms are to be treated. In this case, Applicants have not provided what is being treated by claims 10 and 11, who the subject is, how one can identify said subject (i.e. how one can identify a subject in need), given no specific dose, given no specific dosing regimen, given no specific route of administration, and do not specify what diseases or symptom they intend to treat.

Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the mere germ of an idea does not constitute enabling disclosure. *Genentech Inc. v. Novo Nordisk* 42 USPQ2d 1001.

As the Supreme Court said in *Brenner v. Manson*, 148 USPQ at 696: "a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion." As U.S. Court of Customs and Patent Appeals stated *In re Diedrich* 138 USPQ at 130, quoting with approval from the decision of the board: "We do not believe that it was the intention of the statutes to require the Patent Office, the courts, or the public to play the sort of guessing game that might be involved if an applicant could satisfy the requirements of the statutes by indicating the usefulness of a claimed compound in terms of possible use so general

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as to be meaningless and then, after his research or that of his competitors has definitely ascertained an actual use for the compound, adducing evidence intended to show that a particular specific use would have been obvious to men skilled in the particular art to which this use relates.”

Claims 12-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for increasing the bladder capacity does not reasonably provide enablement for preventing or treating the disorders embraced by these claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicants have not demonstrated nor have they alleged there is any correlation between the *in vitro* assays they disclose in pages 77-78 and clinical efficacy against any disease. Case law is clear on this point. In an unpredictable art, such as CNS disease therapy, *in vitro* assays may be used for enablement only if there is a well-established correlation between the assay and clinical efficacy.

The claims are rejected because the specification does not reasonably provide enablement for preventing or treating the diseases recited. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The how to use requirement of the enablement statute, when applied to method claim, refers to operability and how to make the claimed method work “The factors to be considered (in making an enablement rejection) have been summarized as the quantity of experimentation

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necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims”, In re Rainer 146 USPQ 218 (1965); In re Colianni, 195 USPQ 150, Ex parte Formal, 230 USPQ 546. The issue is the correlation between clinical efficacy for preventing or treating the diseases/conditions of these claims and Applicants' in vitro assay.

a) Determining if any particular claimed compound would prevent or treat the diseases/conditions recited would require synthesis of the compound, formulation into a suitable dosage form, and subjecting it to clinical trials with a number of fundamentally different diseases or conditions claimed, or to testing them in an assay known to be correlated to clinical efficacy of such treatment. This is a large degree of experimentation.

b) The direction concerning treating these diseases found in the specification merely states Applicants' intention to do so. Since no NK1 receptor antagonist has ever been used to prevent or treat the diseases recited how is the skilled physician to know what dose to use for each of these different diseases? Applicants do not assert and it is not art-recognized that the in vitro assay described is correlated to clinical efficacy of the diseases claimed.

c) There is no working example of treatment of any rejected disease in man or animals.

d) The nature of the invention is clinical treatment of diseases/conditions with NK1 antagonists which involves physiological activity.

e) The state of the clinical arts in the NK1 receptor antagonist related diseases is extensive with no single report of success.

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f) The artisan using Applicants invention would be a physician with a MD degree and several years of experience.

g) It is well established that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved", and physiological activity is generally considered to be an unpredictable factor. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

h) The scope of the claims involves all of the thousands of compounds as well as the hundreds of diseases embraced by the claims. Thus, the scope of the claim is very broad. The scope of uses embraced by these claims is not remotely enabled based solely on instant compounds ability to antagonize the NK1 receptor.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 571-272-0668. The examiner can normally be reached Tuesdays to Fridays between 8:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bruck Kifle, Ph.D.
Primary Examiner
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BK
July 8, 2005